REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The Examiner is thanked for considering claims 8, 9, 12 and 14-16 to be allowable.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-16 are pending. Claim 1 is amended, without prejudice. No new matter is added.

Applicants expressly state that the claims, as amended, are intended to include and encompass the full scope of any equivalents as if the claims had been originally filed and not amended. Thus, Applicants hereby expressly rebut any presumption that Applicants have narrowed or surrendered any equivalents under the doctrine of equivalents by amending the claims, or by presenting any remarks in this paper, and in no way do Applicants disclaim any of the territory between the original claims and the amended claims with respect to any equivalent subject matter.

No fee is required in connection with the filing of this Amendment. If any fee, however, is deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

II. 35 U.S.C. § 102 REJECTION

Claims 1-7, 10 and 11 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by eight (8) CA Registry entries. The amendment to claim 1, however, renders the rejection moot.

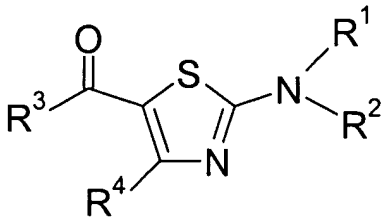
Consequently, reconsideration and withdrawal of the Section 102 rejection are respectfully requested.

III. 35 U.S.C. § 103 REJECTION

Claims 1-7, 10, 11 and 13 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,649,146 to Takaya et al. Applicants disagree.

The Examiner is respectfully reminded that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the teachings in the cited document. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, for a Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, the Takaya patent fails as evidence of unpatentability. The Takaya patent relates to thiazole derivatives having cardiotonic activity for the treatment of heart disease. The Takaya patent, however, fails to teach, suggest or motivate a skilled artisan to practice the instantly claimed compound of the formula I:



(I)

and a method and pharmaceutical composition comprising the compound of the formula I.

The Examiner argues that the instant invention is unpatentable presumably because: (1) Takaya generically describes the instant compounds, and (2) Takaya motivates a skilled artisan to prepare other compounds having cardiotonic activity. Such reasoning is unpersuasive and contrary to settled law. Firstly, the instant claims are a species of the general formula recited in Takaya and are, therefore, patentable.

Secondly, and contrary to the Examiner's reasoning, there is no suggestion or motivation in the Takaya patent to select a sub-genus with the expectation that it would successfully act as a neuropeptide Y antagonist for the treatment or prophylaxis of obesity in a patient in need thereof. There is simply no reason to modify the Takaya compounds in order to derive the instantly claimed neuropeptide Y antagonists. The Examiner's rational and motivation for *prima facie* obviousness, therefore, are negated.

Even assuming, *arguendo*, that one skilled in the art would consider the Takaya patent in order to extrapolate the instant invention therefrom, such an endeavor would amount to, at most, an "obvious to try" scenario. The Federal Circuit is quite clear, however, that "obvious to try" cannot be the basis for rendering an invention unpatentable. *In re Fine,* 5 U.S.P.Q. 2d 1596,

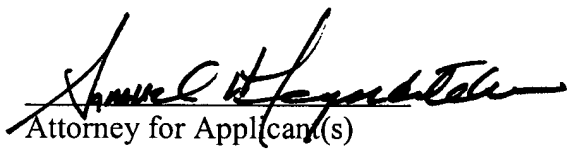
1599 (Fed. Cir. 1988). And as "obvious to try" would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law.

Accordingly, reconsideration and withdrawal of the Section 103 rejection are respectfully requested.

CONCLUSION

In view of the remarks herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,



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